

## REMARKS

In the Office Action mailed on April 4, 2008, the finality of the prior Office Action was removed. Applicant is grateful for the Examiner's reconsideration of previous grounds of rejection, and is hopeful that prosecution can now advance.

Claims 1-2, 8, 12, 26 and 33-34 stand rejected as being obvious under 35 U.S.C. §103(a) in view of a combination of U.S. Patent No. 5,758,465 to Logue ("the '465 patent") and U.S. Patent No. 6,692,206 to Clinch et al ("the '206 patent"). Claims 32, 35 and 36 have been rejected under 35 U.S.C. §103(a) as obvious over the '465 patent in view of the '206 patent, in further view of U.S. Patent No. 6,238,261 to Lang ("the '261 patent"). These rejections are traversed for the reasons set forth below.

**A. CLAIM 1 AND ALL CLAIMS DEPENDENT THEREON ARE ALLOWABLE SINCE THE '206 PATENT FAILS TO TEACH THE REQUIRED STRUCTURE OF THE CLAIMED ANTI-ROTATION ELEMENTS.**

Claim 1 requires " ... at least four anti-rotation elements on said mounting portion". The Examiner admits that the '465 patent fails to teach or suggest these required elements, but instead cites the '206 patent for these elements. Claim 1 also recites that the anti-rotation elements be "configured for *penetratingly engaging the substrate* that the fastener is driven into and that frictionally holds the fastener in place and for *counteracting a moment acting upon said rod hanger as the rod is threadably received* by said rod receiving portion, ..." (emphasis added). These structural limitations are not disclosed or suggested by the '206 patent.

The '206 patent fails to teach that the dimples 148, 150, and 160 be configured for penetratingly engaging any substrate, or for counteracting a moment acting upon a rod hanger as a rod is threadably received (i.e., counteracting a rotational moment). Instead, the '206 patent teaches that the dimples 148, 150, and 160 formed of metal promote the welding of the caged nut assembly 100 and mating surface 157: "the cage nut assembly 100 is positioned at a mating surface 157 such that the dimples 140, 142, 148, 150 are in contact with the mating surface 157. The cage nut assembly 100 is then welded to the mating surface 157 with the assistance of the dimples (140, 142). During welding, ... (t)he half dimples 148, 150 also assist in the welding the cage nut assembly 100 to the mating surface 157 ..." Column 4, line 67 - Column 5, line 8; see also Figure 2. In fact, the '206 patent addresses the concept of anti-rotation in context of resisting torque on the captured nut (Col. 1, l. 18-21), however the anti-torque strength of the assembly is provided by welding the dimples in place, which is far different from the claimed apparatus.

It is submitted, in fact, that it is not possible for the dimples taught by the 206 patent to penetratingly engage the mating surface 157. The '206 patent teaches that the cage nut assembly 100 is *welded* to the mating surface 157 and that the dimples 140, 142 assist in this welding. Both the dimples 140, 142 and mating surface 157 must therefore be metal, with penetrating engagement between the two therefore impossible.

Accordingly, the dimples of the '206 patent do not meet the structural requirements of claim 1. The '206 patent fails to teach that the dimples penetrate a

substrate to counteract a moment acting on the rod hanger as a rod is threadably received. The obviousness rejection is therefore improper and must be removed.

**A.(2) THE '206 PATENT FAILS TO TEACH ANTI-ROTATION ELEMENT ENGAGEMENT WITH SUBSTRATE AS REQUIRED BY CLAIM 1**

Claim 1 recites, among other elements, that the anti-rotation elements are configured for engaging the substrate *that the fastener is driven into and that frictionally holds the fastener* in place. That is, the anti-rotation elements engage the *same* substrate that frictionally holds the fastener in place, with an example being the substrate 14 (e.g., a ceiling) as illustrated in FIG. 1 of the application. The '206 patent fails to teach or suggest this. Instead, the '206 patent teaches that its cage nut assembly dimples be welded to the mating surface 157. The '206 patent does not teach that the mating surface 157 receives any fastener or frictionally holds any such fastener in place.

These are yet additional reasons that the '206 patent fails to disclose or suggest the structural limitations of claim 1 and is therefore an improper reference for rejecting claim 1 as obvious.

**A.(3) DEPENDENT CLAIMS 2, 8, 12, 26 AND 32-34 ARE ALLOWABLE**

Claims 2, 8, 12, 26 and 32-34 depend from claim 1 and are allowable for the same reasons as are that claim.

**B. CLAIMS 32, 35 AND 36 ARE ALLOWABLE**

Claims 32, 35 and 36 have been rejected over the '465 patent in view of the '206 patent and in further view of the '261 patent. The rejections of claims 32, 35 and 36 are traversed for the reasons set forth below.

**B.(1) THE '206 PATENT FAILS TO DISCLOSE OR SUGGEST THE REQUIRED ANTI-ROTATION ELEMENTS.**

Claims 35 and 36 are independent, and claim 32 depends from claim 36. Each of claims 35 and 36 require at least four anti-rotation elements configured for penetratingly engaging a substrate that the fastener is driven into and that frictionally holds the fastener in place and for counteracting a moment acting upon the rod hanger as the rod is threadably received by the rod receiving portion. The '206 patent has been cited as disclosing these required elements. For the reasons set forth above in relation to claim 1, it is submitted that these required elements of claims 32, 35 and 36 are not disclosed by the '206 patent and that the claims are therefore allowable.

**B.(2) THERE IS NO MOTIVATION TO COMBINE THE CITED PATENTS SINCE THEY ARE FROM VERY UNRELATED ARTS – ANY COMBINATION OF THESE VERY DIFFERENT PATENTS REQUIRES IMPERMISSIBLE HINDSIGHT.**

It is submitted that the obviousness rejection of claims 32, 35 and 36 is improper because there is no suggestion or motivation to combine the cited references with one another. Citing these unrelated references in combination improperly views the prior art only with the benefit of hindsight gained after considering the claimed invention.

The '465 patent teaches a device for securing a rod to a ceiling, and the '206 patent teaches a cage nut assembly. Accepting only for the sake of argument that some motivation can be found for combining these unrelated references, no motivation can be found for combining them with the significantly different '261 patent disclosing a light transmitting peg for use in a toy to reject claims 32, 35 and 36.

The MPEP states that a *prima facie* case of obviousness requires, among other things, objective evidence which establishes a teaching to modify the prior art reference components to construct a device substantially equivalent to that claimed. This generally encompasses two sub-steps: (1) identifying objective evidence teaching how to modify the prior art components; and (2) identifying objective evidence teaching how to combine the modified individual components. MPEP §§2141, 2143.

The Examiner must set forth a rationale, supported by objective evidence, that the prior art provides a teaching to modify and/or combine the prior art reference components to achieve the claimed structure. *Id.* The preferable evidence is an express teaching to modify/combine within the properly defined sources of prior art. In the absence of such express teaching, an Examiner may attempt to establish a rationale to support a finding of such teaching reasoned from, or based upon, express teachings taken from the prior art. MPEP § 2144; *In re Dembiczak*, 50 U.S.P.Q. 2d 1614 (Fed. Cir. 1999).

This has been referred to as the “teaching/suggestion/motivation test” (TSM). Although a rigid application of TSM was rejected in *KSR Int’l. Co. v. Teleflex, Inc.*, 82 USPQ2d 1385 (2007), the test was not discarded. The Court only required

consideration of the general knowledge of those skilled in the art and other factors, using a common sense approach to obviousness, but also warned against overly broad findings of obviousness:

...a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. ... (I)t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

Id., at 1741. The MPEP also warns against overly broad findings of obviousness based on the impermissible use of hindsight. The MPEP has set forth at least two rules that ensure against such rejections. The first is that it is impermissible to use hindsight gained from considering the application:

... the Examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was ... (made) ... Knowledge of an Applicant’s disclosure must be put aside in reaching this determination, ... The tendency to resort to “hindsight” based upon an Applicant’s disclosure is often difficult to avoid due to the very nature of the examination process.

MPEP §2142. Thus, if the only objective evidence of such teaching to modify and/or combine is found in the applicant’s disclosure, no evidence of such teaching exists.

The second rule requires that an alleged advantage or beneficial result that would have been produced by a modification and/or combination of the prior art reference components must be found in objectively verifiable teachings of the prior art. MPEP §2144. Thus, to avoid the use of impermissible hindsight, these MPEP rules make

clear that absent objective evidence (sufficient to satisfy the preponderance of the evidence standard), no teaching of such modification and/or combination exists.

In consideration of the above, it is submitted that the obviousness rejections of claims 32, 35 and 36 is contrary to the rules set forth by the courts and the MPEP. There has been no objective evidence put forth suggesting that one considering the '206 and '465 patents related to tools and fasteners would have any reason to consider or look to the light emitting toy art where the '261 patent is found. Simply put, a fastener designer would not look to a light emitting toy for ideas. The '261 patent does not have any overlapping international or US classifications or field of search classifications. The obviousness rejection of claims 32, 35 and 36 over the '261 patent can only be made through the impermissible use of hindsight gained after considering the present application, is improper, and should be withdrawn.

**B.(3) THE '261 PATENT FAILS TO DISCLOSE OR SUGGEST THE REQUIRED RESILIENT COVER.**

THE '261 PATENT FAILS TO DISCLOSE ANTI-ROTATION ELEMENTS HAVING A RESILIENT COVER, BUT INSTEAD TEACHES LIGHT EMITTING PEGS WITH AN OPAQUE PAINT LAYER

Each of claims 32, 35 and 36 require a resilient cover extending over the anti-rotation elements. The Examiner admits that the '206 and '465 patents fail to disclose this required element, but instead cites the '261 patent. In particular, the Examiner states that "... Lang '261 teaches wherein a mounting with dimples (36) and each dimple is secured by a resilient cover (40-plastic)." It is submitted that this is incorrect.

The '261 patent fails to disclose any anti-rotation elements or dimples. The Office Action is incorrect in its assertion that element 36 is a "dimple." Instead, the '261 patent teaches that element 36 is a protruding end surface of a light emitting peg 10. Col. 4, lines 12-15. The '261 patent teaches that light emitting pegs 10 are useful in a child's toy - namely a light emitting pegboard which allows the pegs 10 to be arranged in desired geometric shapes. Column 4, line 59 - column 5, line 4. Accordingly, the '261 patent fails to teach anti-rotation elements or dimples having a resilient cover and therefore cannot support the obviousness rejection of claims 32, 35 and 36.

The Examiner further cites element 40 of the '261 patent as disclosing the resilient cover extending over the anti-rotation elements recited by claims 32, 35 and 36. It is submitted that this is incorrect. Putting aside for the moment that the '261 patent teaches only light emitting pegs 10, and not anti-rotation elements or dimples, the '261 patent further fails to teach the structural limitations of the resilient cover required by each of claims 32, 35 and 36.

The '261 patent does not teach that element 40 is a resilient cover for enhancing the adhesion of a mounting portion with a substrate. Instead, the '261 patent teaches that element 40 is paint or other coating that is applied to partially mask or partially block light from entering into peg end surface 36, and is applied in a very thin coating over only a portion of the peg 10: "... the masking material 40 is a white lacquer paint that is sprayed onto the distal ends 34 of the shaft portions 24 in a thickness that is sufficient to partially, but not completely, block the transmission of light therethrough." Column 4, lines 32 - 36.



Further, claims 32, 35 and 36 recite that the resilient layer be configured for enhancing the adhesion of the mounting portion with the substrate. Light masking paint layer 40 does not satisfy this structural limitation. Taking Fig. 5 of the '261 patent by way of example, light masking layer 40 is disclosed as covering the end 36 of the light emitting peg 10, but otherwise not engaging any substrate or any other surface. Fig. 5 makes clear that the layer is exposed to light source 20. Additionally, should the paint layer 40 engage a substrate, its intended purpose would be defeated since no light could penetrate the layer. Finally, one seeking a resilient layer for enhancing adhesion would not consider using a light masking layer made of paint since this would not be expected to (and could not) enhance adhesion.

Accordingly, light masking element 40 for covering the end of the light emitting peg 10 from a child's toy cannot satisfy the required structural limitations of the anti-rotation element including a required by claims 32, 35 and 36.

THE '261 PATENT FAILS TO DISCLOSE THE REQUIRED ADHESIVE OR THERMOFORMED LAYER AND TEACHES AWAY FROM IT

Each of claims 32, 35 and 36 require a resilient cover extending over the anti-rotation elements. Claims 32 and 35 further require that the resilient cover be formed of a polymer and be secured to the anti-rotation elements by one of a chemical adhesive or thermoforming. The Examiner cites element 40 of the '261 patent as disclosing this. Putting aside for the moment the above noted shortcomings of the light

masking paint layer 40 covering one end of the peg 10, it is submitted at the '261 patent further fails to disclose the recited adhesive or thermoforming of claims 32 and 35.

Instead, the '261 patent only discloses covering peg 10 with light masking material (paint), and teaches doing so through spraying: "...the masking material 40 is a white lacquer paint sprayed onto the distal ends 34 of shaft portions 24..." col. 4, lines 33-35. The '261 patent fails to disclose an adhesive that holds a *separate* polymer cover on its dimples, or (in the alternative) *thermoforming* a paint layer 40 over its pegs 10. One considering the '261 patent would not be led to this requirement since it is well known in the art that paint does not require an adhesive or thermoforming.

Furthermore, the '261 patent teaches away from this required element of claims 32 and 35 since the '261 patent teaches it is important that the light masking layer 40 mask some, but not all of the light passing through the light emitting peg: "this arrangement is used to partially mask or partially block light from entering into the end surfaces 36 of the shaft portions 24 ... it is preferable that the masking material 40 be applied in a thickness which does not completely mask all light being transmitted through the material 40." Column 4, lines 24 – 31.

One considering the '261 patent would therefore not be led to the required second layer of claims 32 and 35, since the '261 patent teaches minimizing thickness of its paint layer 40 so as to allow some light transmission through the end of light emitting peg 10. This is still another reason that the '261 patent cannot support the obviousness rejection of claims 32, 35 and 36.

THE '261 PATENT FAILS TO DISCLOSE THE REQUIRED RESILIENT LAYER EXTEND FULLY OVER THE ANTI-ROTATION MEMBERS AS REQUIRED BY CLAIMS 32 AND 35

Claims 32 and 35 recite that the resilient cover extend *fully* over the anti-rotation elements. Putting the multiple shortcomings of the '261 patent discussed above aside for the moment, it is submitted that the '261 patent fails to disclose this. In particular, the '261 patent expressly teaches that the paint layer 40 *not cover the entire peg 10*, or even the entire peg shaft portions 24: "The light masking material 40 is preferably sprayed over the distal end 34 so as to cover the entire end surface 36 up to the hemisphere line, but may fall short of the hemisphere line or extend slightly beyond the hemisphere line, partially up the side of the shaft portion 24." Column 4, lines 36 – 40. Accordingly, the '261 patent expressly teaches that the paint layer 40 not cover the entire peg 10 with the result that it cannot support its obviousness rejection of claims 32 and 35.

C. CONCLUSION

It is submitted that all the claims in their current form are allowable over the cited prior art for at least the following reasons:

- The '206 patent fails to teach anti-rotation members configured for penetrating engagement and for counteracting a moment acting upon a rod hanger as is required by all claims.
- The '206 patent fails to teach anti-rotation members that engage a substrate into which the fastener is driven and that frictionally holds the fastener in place.

- The '261 patent discloses a light emitting peg for a child's toy and is therefore from a very different art than the tool and fastener arts – there can be no motivation or suggestion to combine it with other cited references to reject claims 32, 35 and 36.
- The '261 patent teaches a light masking paint layer 40 that fails to meet the structural limitations of claims 32, 35 and 36.

Timely consideration is requested. Should issues remain for resolution before claims can be allowed, the undersigned attorney will be pleased to discuss the same over the phone. All correspondence should continue to be directed to Applicant's primary attorney Ms. Lisa Soltis at the correspondence address of record.

Respectfully submitted,

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